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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,361	12/11/2006	Stefan Golz	004974.01111	2140

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EXAMINER	
WEN, SHARON X	

ART UNIT	PAPER NUMBER
1644	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/575,361	GOLZ ET AL.	
	Examiner	Art Unit	
	SHARON WEN	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2006*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18 and 21-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-18, 21-23* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's amendment, filed 04/11/2006, has been entered.

Claims 19-20 and 24-26 have been canceled.

Claims 1-18 and 21-23 are pending and currently under Restriction Requirement.

2. The claims recite multiple pharmaceutical composition comprising a therapeutic agent wherein said therapeutic agent is i) a small molecule, ii) an RNA molecule, iii) an antisense oligonucleotide, iv) a polypeptide, v) an antibody, or vi) a ribozyme. The recited therapeutic agents are patentably distinct because their structures, physicochemical properties and/or mode of action are different, and they do not share a common structure that is disclosed to be essential for common utility. Therefore, the restriction has been set forth for each as separate groups, ***irrespective*** of the format of the claims.

Election/Restrictions

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-11, drawn to a method of screening for therapeutic agents comprising contacting a test compound with a NPEPL1 polypeptide.

Group II, claim(s) 12-17, drawn to a method of screening for therapeutic agents comprising contacting a test compound with a NPEPL1 polynucleotide.

Group III, claim(s) 18, drawn to a method of diagnosing a disease comprising determining the amount of a NPEPL1 polynucleotide in a sample.

Group IV claim(s) 21, drawn, in part, to a pharmaceutical composition comprising a therapeutic agent which regulates the activity of a NPEPL1 polypeptide, wherein said therapeutic agent is a **small molecule**.

Group V claim(s) 21, drawn, in part, to a pharmaceutical composition comprising a therapeutic agent which regulates the activity of a NPEPL1 polypeptide, wherein said therapeutic agent is an **RNA molecule**.

Group VI claim(s) 21, drawn, in part, to a pharmaceutical composition comprising a therapeutic agent which regulates the activity of a NPEPL1 polypeptide, wherein said therapeutic agent is an **antisense oligonucleotide**.

Group VII claim(s) 21 and 23, drawn, in part, to a pharmaceutical composition comprising a therapeutic agent which regulates the activity of a NPEPL1 polypeptide, wherein said therapeutic agent is a **polypeptide**

Group VIII claim(s) 21, drawn, in part, to a pharmaceutical composition comprising a therapeutic agent which regulates the activity of a NPEPL1 polypeptide, wherein said therapeutic agent is an **antibody**.

Group IX claim(s) 21, drawn, in part, to a pharmaceutical composition comprising a therapeutic agent which regulates the activity of a NPEPL1 polypeptide, wherein said therapeutic agent is a **ribozyme**.

Group X claim(s) 22, drawn, to a pharmaceutical composition comprising a NPEPL1 polynucleotide.

4. The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: PCT Rule 13.2 defines “special technical features” as “those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” In addition, unity of invention has to be considered in the first place only in relation to the independent claims.

The special technical feature does not contribute over prior art for reasons stated in the international search report PCT/EP04/011007 and reiterated herein for Applicant's convenience. Bandman et al. teach a polypeptide named HUPM which comprises an amino acid sequence of the NPEPL1 (SEQ ID NO: 2) of the present invention (see WO 99/36550, cited on IDS). In addition, Bandman et al. teach using the polypeptide in a

pharmaceutical composition (see page 38). Therefore, the unity of invention does not exist in the present invention.

Species Election

5. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

6. If any one of Groups I-III is elected, Applicant is required to elect a species and ultimate species of disease as recited the claims and disclosed in the instant specification on pages 39-58 (e.g., metabolic disease: hyperaminoacidemia **OR** inflammatory disease: asthma).

7. If Group I is elected, Applicant is required to elect a specific activity of said polypeptide as disclosed in the instant specification on page 84, for example (e.g., "NPEPL1 enzyme activity that can be assessed by a standard in vitro serine/metallo/… protease assay"

8. If any one of Groups I-II is elected, Applicant is required to elect a specific step of contacting as recited in claims 4-6 and 14-15 (e.g., "in or at the surface of a cell" **OR** "in a cell-free system").

9. If Group I is elected, Applicant is require to elect a specific method as recited in claims 7-8 (e.g., "wherein the polypeptide is coupled to a detectable label" **OR** "wherein the compound is coupled to a detectable label").

10. If Group I is elected, Applicant is required to elect a specific method recited in claims 10-11(e.g., "wherein the polypeptide is attached to a solid support" **OR** "wherein the compound is attached to a solid support").

11. If Group II is elected, Applicant is require to elect a specific method as recited in claims 7-8 (e.g., “wherein the polynucleotide is coupled to a detectable label” **OR** "wherein the compound is coupled to a detectable label”).

12. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: see Bandman et al.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

13. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

15. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARON WEN whose telephone number is (571)270-3064. The examiner can normally be reached on Monday-Thursday, 8:30AM-6:00PM, ALT. Friday, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen O'Hara can be reached on (571)272-0878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sharon Wen, Ph.D./
Examiner, Art Unit 1644
March 4, 2008

/Phillip Gambel/
Phillip Gambel, Ph.D., J.D.
Primary Examiner, Art Unit 1644
03/11/2008